

REMARKS

Claims 1-29 are pending in the present application. The present Non-Final Office Action dated January 23, 2006 has rejected Claims 1-20 and objected to Claims 2, 19, and 20. Claims 1-6, 9, 13-15, and 18-20 have been amended to further clarify the subject matter of the invention. New Claims 21-29 have been added. No new matter has been added by way of this amendment. For at least the reasons discussed below, Applicants submit that the pending claims are patentable over the prior art of record.

Claim Objections

Claim 2 is objected to because of the terms: "in" field and "sent" field. Applicants have amended the claim as suggested in the Office Action and therefore requests that the objection to this Claim be withdrawn.

Claim 19 and 20 are objected to because "a method" cannot be dependent on the claim(s) of "a computer readable medium." The pre-amble of Claims 19 and 20 have been amended to refer to the "computer readable medium." Thus, Applicants request that this objection be withdrawn.

35 USC 101 Rejections

The Office Action rejects Claims 1-15 under 35 USC 101 as being directed to non-statutory subject matter. Specifically, the use of a computer has not been indicated being used to perform the method steps. Applicants have amended the preamble of independent Claims 1 and 9 to clarify a computer implemented method. Dependent Claims 2-8 and 10-15 depend from Claims 1 and 9 respectively, and should be allowable for at least the same reasons as for their parent Claims. Accordingly, Applicants request that this rejection be withdrawn.

35 USC 102 Rejections

The Office Action rejects Claims 1-6, 8-13, 15-20 under 35 USC 102(b) as being anticipated by Harms et al. (US Publish 2003/0078981). Applicants have amended Claims 1, 9, 13, 16, and 18 to clarify the invention and correct antecedent basis. Applicants have amended dependent Claims 3-6, 12, 14, and 15 to correct antecedent basis.

With respect to amended independent Claim 1, Harms does not disclose “searching through at least one archive of e-mails for an e-mail address, based on a different application associated with each of the at least one archive.” In particular, Harms does not disclose the use of a “different application.” Applicants’ Specification teaches searching of e-mails based on a different applications (e.g. Microsoft Outlook, Netscape mail, AOL mail, Yahoo! Groups, Yahoo! Greetings). See e.g., Specification, p. 7, lines 16-20 and p. 14, lines 1-17. At most, Harms discloses “[t]he information retrieved from the messages can include identification information of senders and/or recipients, such as, an email address and/or a name.” Harms, p. 2, para. 0026. Nothing in Harms suggests or discloses retrieving based on different applications. Therefore, Harms does not disclose the amended limitation of Claim 1. Accordingly, Harms does not anticipate Claim 1, and Claim 1 should be in condition for allowance.

With respect to amended independent Claim 9, Harms does not disclose “accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application.” The Specification teaches accessing, over a network, an electronic archive. See e.g., Specification, Figure 1 (showing networked components), p. 7, lines 30-32, p. 8, lines 1-30, p. 10, lines 24-32. In contrast, Harms’ system monitors and scans for messages in an e-mail inbox of messages residing on a local database (e.g. on the portable device). See Harms Abstract; Figure 1; p. 3, para. 0030 (“information from the messages in the database or storage device is retrieved”), para. 0031 (“database or memory structure associated with the portable device”). Nothing in Harms discloses or suggests that the Harm’s system monitors and scans for messages over a network. At most, Harms discloses a network coupled to the mobile device, but Harms does not disclose that the

network is further coupled to an e-mail archive that is accessed over the network. See Harms, Figure 1. , Harms does not disclose the amended limitation of Claim 9. Thus, Harms does not anticipate Claim 9.

Moreover, Harms does not disclose “accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application.” The Specification teaches the accessed electronic archive may be an application comprising a list of e-mail addresses generated with a first application (e.g. Microsoft Outlook, Netscape mail, AOL mail, Yahoo! Groups, Yahoo! Greetings). See e.g., Specification, p. 6, lines 19-24 and p. 13, line 29 through p. 14, line 17. Harms does not teach accessing such an electronic archive. Harms teaches accessing an inbox of email messages. Therefore Harms does not anticipate Claim 9, and Claim 9 should be in condition for allowance. Similarly, Harms does not disclose or suggest a second list of e-mail addresses generated with a second application, as required by dependent Claim 13.

Amended Claim 16 recites similar, albeit different limitations to amended Claim 1. For example, amended Claim 16 recites “means for scanning configured to search one or more archives for at least one e-mail address and to retrieve the at least one e-mail address, wherein each of the one or more archives is generated with a different application.” As discussed above, the specification discloses multiple applications to generate different archives of email addresses. Therefore, Claim 16 should be allowable for substantially similar reasons as for Claim 1.

With respect to amended independent Claim 18, the limitations are similar, albeit different from Claim 1. Therefore, for at least the same reasons, Harms does not disclose the amended limitation of Claim 18. Thus, Harms does not anticipate Claim 18.

Furthermore, dependent Claims 2-8, 10-15, 19-20, 22-27 depend from Claims 1, 9, 18, and 23 respectively, and are patentable for at least the same reasons as the independent claims from which the dependent claims depend. Accordingly, the dependent claims should be allowable at least for the same reasons as for their parent Claims.

35 USC 103(a) Rejections

Claim 7 is rejected under 35 USC 103(a) as being unpatentable over Harms in view of Creswell et al. (US Patent 6,564,264). Applicants respectfully submit that Claim 7 should be allowable because it depends from Claim 1 which should be allowable, as discussed above.

Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Harms in view of Cortright et al. (US Patent 6,895,426). Applicants respectfully submit that Claim 14 should be allowable because it depends from Claim 9 which should be allowable, as discussed above.

New Claims

New independent Claim 21 has been added and finds support in the Specification. See e.g., Specification, Figure 1, p. 7, lines 30-32, p. 8, lines 1-30, p. 10, lines 24-32. Harms does not disclose “accessing, over the network, a plurality of archives of e-mails” Harms also does not disclose “providing to a user device, over the network, an access to the electronic address book,” as recited in Claim 21. Instead, Harms’ address book resides on a portable device and is provided to a user through the portable device. See Harms, Abstract claim 1 p. 1, para. 0009; p. 2, para. 0027-0028. Nowhere in Harms is it disclosed that the electronic address book is accessed or provided over the network. Thus, Harms does not anticipate new Claim 21. Therefore, Claim 21 should be in condition for allowance. Further, new Claims 22-27 depend from Claim 21 and should be in condition for allowance at least for this reason.

New independent Claim 28 has been added and finds support in the Specification. See e.g., Specification, p. 6, lines 19-24, p. 7, lines 16-20 and p. 13, line 29 through p. 14, line 17. Harms does not disclose “accessing a first source electronic address book for a first e-mail address, the first source electronic address book comprising a list of e-mail addresses generated with a first application,” as recited in Claim 28. Thus, Harms does not anticipate new Claim 28. Therefore, Claim 28 should be in condition for allowance. Further, new Claim 29 depends from Claim 28 and should be in condition for allowance at least for this reason.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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